

RESPONSE TO OFFICE ACTION

A. Status of the Claims

Claims 1-18 were issued in U.S. Patent No. 6,131,205. Claims 19-31 were added in the Preliminary Amendment filed with the request for reissue on August 6, 2001. Thus, claims 1-31 were pending at the time of the present Action. Claims 19, 27 and 30 were amended in response to the Office Action dated May 2, 2002, to clarify the subject matter of the claims. No claims are amended, added or cancelled herein. Thus, claims 1-31 remain pending. A copy of the currently pending claims is attached hereto as Appendix A.

B. A Corrected Reissue Oath/Declaration Is Included Herewith

The Action first points out that the reissue oath/declaration filed with the application was defective in that it identified the inventor as a joint inventor but failed to include signatures from any additional inventors. Applicant submits herewith a revised oath/declaration stating that she is the sole inventor of the invention claimed.

The corrected oath/declaration also appoints Ms. Teresa J. Schultz as Applicant's agent for communication with the Office. Please forward any reply to this communication, and any future communications, to the address below:

Teresa J. Schultz, Esq.
7324 Old Mill Run
Fort Worth, Texas 76133
Telephone: (817) 551-4321
Facsimile: (817) 423-2591

C. Applicant Has Incorporated the Changes Made by the Certificate of Correction

The Action next asserts that Applicant has failed to incorporate the changes made by the Certificate of Correction, referring to MPEP § 1411.01. Section 1411.01 states that changes

made to the patent by Certificate of Correction should be incorporated without the use of underlining or brackets. Applicant acknowledges that the Preliminary Amendment incorrectly requested amendment of the claims to incorporate the Certificate of Correction changes. The amendments to the specification requested in the certificate of correction are included herein, without underlining or brackets, in Appendix B.

D. The Claims Are Not Obvious

The Action rejects claims 27-31 as being obvious over Henschel. Henschel is said to disclose a “*garment or cap having invisible or transparent pockets P of sheer material 13 for suspending embellishments...*” (Action, page 2, para. 5, emphasis added). The Action asserts that the use of fabric for portions of the cap is old and well known and would have been obvious. Applicant respectfully traverses.

The crux of the present invention is that the claimed pocket is virtually invisible on the garment so that the embellishments suspended therein appear to be “floating” on the garment. The form of the pocket also allows for easy deposit and removal of the embellishments so that live flowers or keepsake items may be suspended on a garment. The shape of the pocket, the size of the pocket and the location of the pocket are relatively unimportant – virtually any shape or size pocket is within the scope of the invention.

The invention of claims 27-31 is directed to a garment having one or more sheer pockets for suspending an embellishment on the garment where the garment comprises at least one layer of fabric and at least one sheer pocket attached to said fabric. In preferred embodiments, the outside panel of the pocket and the fabric are made of different materials. Applicant defines the term “garment” in the specification as referring to “an entire piece of clothing, such as a formal gown or wedding gown, including all of the various layers of various fabrics that may be a part of

the garment.” Contrary to the Action’s implication, Henschel discloses only a cap with “transparent panels” attached to the head covering portion. There is no mention in Henschel of a “garment.” While Applicant maintains that the garment of the invention encompasses more than formal gowns or wedding gowns, and may, in fact, encompass the long type veil that a bride would wear, which are typically made entirely of sheer materials, it would generally not be understood by the skilled artisan to encompass a cap as is contemplated by Henschel. Nor would the skilled artisan tend look to the art of “cap making” for help in the art of garment making. Therefore, Henschel should not be considered relevant art to the present invention.

The Action seems to take the position that, because a portion of the cap described in Henschel is made from “fabric,” it would have been obvious to make a portion of the garment of the present invention from “fabric.” Of course, it is well known that, for almost as long as people have been wearing garments, they have been made from some kind of fabric. The fact that some or all of the pieces of an invention were known before does not render that invention obvious. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Rather, the cited “reference(s) must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference(s).” *Id.* The present Action contains no suggestion, or “convincing line of reasoning” as to why the skilled artisan in the art of garment making would have looked to a description of a cap with a “transparent plastic panel” forming a pocket in designing the garment of the invention.

In light of the foregoing arguments, Applicant respectfully requests that the obviousness rejection based on Henschel be withdrawn